

Attorney Docket # 2132-47PCON

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Harri VATANEN

Serial No.: 09/868,387

Filed: June 18, 2001

For: Method and System for Implementing a Digital
Signature

Examiner: Not Yet Assigned

Group Art: Not Yet Assigned

Assistant Commissioner for Patents
Washington, DC 20231

RECEIVED

12 MAR 2002

Legal Staff
International Division

PETITION

SIR:

This Petition is submitted pursuant to 35 U.S.C §118 and 37 C.F.R. §1.47(b) to request that the U.S. Patent and Trademark Office ("PTO") accept the filing of the above-identified US Patent Application by Sonera Smarttrust Oy, a corporation of Finland, *in lieu* of by the sole inventor, Harri Vatanen, on the ground that Mr. Vatanen has refused to sign the Declaration in support of the subject US application.

The undersigned, and other attorneys in the law firm of the undersigned, are the attorneys for Sonera Smarttrust Oy and Sonera Oy, both of which are corporations of Finland; Sonera Smarttrust Oy is a wholly-owned subsidiary of Sonera Oy, and are in effect one company (see attached Declaration of European Patent Attorney Markku Simmelvu, Exhibit 1 hereto). The undersigned is empowered and has the authority to act on behalf of Sonera Oy and Sonera

Smarttrust Oy; Sonera Smarttrust Oy, which holds the patents of its parent Sonera Oy, is the proper and lawful assignee and owner of the invention of the subject US application.

In brief, and as explained more fully below, (1) Mr. Vatanen has refused to sign the Declaration in support of this application, despite repeated requests that he do so, and (2) Mr. Vatanen has already assigned, both expressly and as a matter of Finnish statutory law, the invention which is the subject of this application to Sonera Smarttrust Oy and is under an agreed-to obligation to execute any necessary documents required in connection with the U.S. application that is the subject of this Petition.

On June 18, 2001, the undersigned filed (by Express Mail) a request under 35 U.S.C. §371 to enter the national phase (i.e. to begin national examination procedures) in the United States from International (PCT) Patent Application No. PCT/FI99/01036, which had been filed on December 15, 1999 and in which the United States was properly designated. This Section 371 national phase filing request was accompanied, *inter alia*, by a copy of the published International Application and by an unexecuted Declaration of the sole inventor, Mr. Harri Vatanen. The International Application claims the priority of Finnish Patent Application No. 982,728, which was filed in Finland on December 16, 1998.

The Finnish priority application was filed by Sonera Oy as applicant, and Sonera Oy thereafter transferred its rights in the Finnish priority application to its wholly-owned subsidiary Sonera Smarttrust Oy (which holds the patent rights of its parent, Sonera Oy). On December 20, 1998, inventor Vatanen executed an Assignment of that Finnish priority application to Sonera Oy (a copy of that Assignment is attached to the Declaration of Markku Simmelvu, Exhibit 1 hereto), in which he expressly transferred "the patent rights [to the invention] in all countries" and agreed "to sign all documents ... which may be required to assert the rights transferred" in the Assignment.

The International (PCT) application, which was filed within the one-year period following the filing of the Finnish application and which claimed the priority of the Finnish application, was filed by Sonera Smarttrust Oy as applicant (for all countries except for the United States). Inventor Vatanen executed a Power of Attorney to the Finnish attorneys of Sonera Smarttrust Oy (Papula Rein Lahtela Oy) in support of the designation, in the International Application, of the United States since Mr. Vatanen, rather than Sonera Smarttrust Oy, would have to be the applicant in the United States. (See Declaration of Markku Simmelvujo and attached copy of that Power of Attorney, Exhibit 1 hereto.)

As noted above, the national phase U.S. application which is the subject of this Petition was filed on June 18, 2001 and was accompanied on filing by an unexecuted Declaration of the sole inventor, Mr. Harri Vatanen. The unexecuted Declaration identified the undersigned and other members and employees of undersigned's law firm (Cohen, Pontani, Lieberman & Pavane) as the record attorneys for the application, and identified undersigned's law firm as the mailing address for all correspondence in connection with the application.

On July 25, 2001, a paper entitled "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office", noting the lack of an executed Declaration of the inventor, was mailed to the undersigned by the PTO. That Notification was received by undersigned's law office on July 27, 2001. A copy of that Notice, as received on July 27, 2001, is attached as Exhibit 2 hereto.

By letter of August 3, 2001, the undersigned informed European patent attorney Markku Simmelvujo, of the Finnish law firm Papula Oy, of our receipt of the Notification. (We correspond with Sonera Oy/Sonera Smarttrust Oy through that Finnish law firm, from whom we also receive the instructions of Sonera Oy/Sonera Smarttrust Oy.) Accompanying that letter of

August 3 we enclosed a copy of the Notification and a "Combined Declaration for Patent Application and Power of Attorney" for execution by inventor Harri Vatanen. A copy of our August 3, 2001 letter and of the Declaration that accompanied that letter are attached as Exhibit 3 hereto.

Sonera Smarttrust Oy has made numerous and repeated attempts to obtain the signature of the sole inventor, Mr. Vatanen, on the Declaration relating to the subject US patent application. Attached as Exhibit 4 hereto is an Affidavit of Paivi Soderman, the corporate patent engineer of Sonera Smarttrust Oy who is overseeing the subject U.S. patent application and who had direct responsibility for obtaining the signature of Mr. Vatanen on the Declaration in support of the U.S. patent application. As reported by Ms. Soderman in her Affidavit, Ms. Soderman has forwarded copies of the Declaration, accompanied by a copy of the patent application, to Mr. Vatanen, and although Mr. Vatanen has repeatedly promised to sign the Declaration he has repeatedly failed to do so, and no other written responses to those communications to Mr. Vatanen have been received. Mr. Vatanen has also been informed that the nonextendible deadline for filing the signed Declaration in the U.S. Patent and Trademark Office to avoid loss of the application is March 25, 2002, but he has nevertheless failed return a signed Declaration to Ms. Soderman or otherwise to Sonera Smarttrust Oy or the Papula law firm, thereby effectively refusing to sign the Declaration.

Inventor Harri Vatanen's last-known, and on information and belief his current, address is Savannah Lindale Close, Virginia Water GU 4NT Surrey, United Kingdom. All communications with Mr. Vatanen seeking his signature on the Declaration for the U.S. application have been directed to that address.

Mr. Vatanen is under a duty to assign the subject US patent application to Sonera Oy or its subsidiary, Sonera Smarttrust Oy, as a direct consequence of his employment by Sonera Oy/Sonera Smarttrust Oy. The attached Exhibit 1 Declaration of European Patent Attorney Markku Simmelvuo, of the Finnish patent firm Papula Oy, states that under Finnish statutory law an employee's inventions are owned by the employee, in this case Sonera Oy (and its subsidiary Sonera Smarttrust Oy). In addition, Mr. Vatanen has already expressly assigned the invention which is the subject of the U.S. application, "in all countries", to Sonera Oy, which in turn has transferred ownership to its wholly-owned subsidiary Sonera Smarttrust Oy. Thus, Sonera Smarttrust Oy is the proper, legitimate and lawful owner of the invention set forth in the subject US patent application and, since Mr. Vatanen as sole inventor of that invention has refused to sign the Declaration in support of the U.S. application, Sonera Smarttrust Oy (or its parent Sonera Oy) is the proper party to sign the Declaration and file the subject application *in lieu* of Mr. Vatanen.

Also attached, as Exhibit 5 hereto, is a Declaration and Power of Attorney for the subject US patent application which has been signed by Antti Vasara, the Chief Executive Officer of Sonera Smarttrust Oy. Mr. Vasara has the authority to execute such documents on behalf of Sonera Smarttrust Oy.

Sonera Smarttrust Oy, as the lawful and legitimate owner of the invention which is the subject of the U.S. patent application, will suffer irreparable damage unless it is permitted to sign the Declaration and file the U.S. application *in lieu* of the non-signing, sole inventor Harri Vatanen. Such irreparable damage is evidenced and established in this case in that the June 18, 2001 filing date of the U.S. application was the final day on which the U.S. application could have been filed in the United States under Section 371 to maintain the priority of Finnish Application No. 982,728 of December 16, 1998. Loss of that priority would now result in a statutory bar to patent

protection of the invention in the United States, since the International Application was published on July 6, 2000.

Based on the foregoing and the enclosed, it is respectfully requested that the U.S. Patent and Trademark Office grant this Petition and accept the filing of the subject U.S. patent application by Sonera Smarttrust Oy in *lieu* of the sole inventor, Harri Vatanen, pursuant to 35 U.S.C. §118 and 37 C.F.R. §1.47(b).

The undersigned hereby declares that all statements made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true; and, further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

A check in the amount of \$1,890.00 in payment of the government fee for a five-month extension of time, a check in the amount of \$130.00 in payment of the government fee for the filing of "missing parts" in response to the April 17, 2001 Notice, and a check in the amount of \$130.00 in payment of the government fee for the filing of this Petition, are enclosed herewith.

03/05/2002 SNAJARRO 00000015 032412 09868387

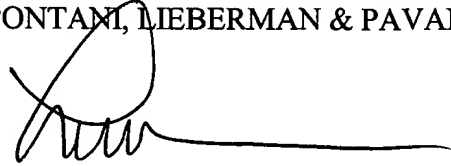
| | | |
|-----------|----------|------------|
| 01 FC:154 | | 130.00 OP |
| 02 FC:122 | | 130.00 OP |
| 03 FC:128 | 70.00 CH | 1890.00 OP |

Any additional fees or charges required at this time in connection with the instant patent application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By

A handwritten signature in black ink, appearing to read 'Lance J. Lieberman', written over a horizontal line.

Lance J. Lieberman
Reg. No. 28,437
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: February 25, 2002

By Express Mail
No. EL727707030US

22.2.2002

STATEMENT

Sonera Smarttrust Oy owns the rights to the invention "Method and system for implementing digital signature", a patent application concerning which is pending in the USA under the application number 09/868,387. A patent has been applied for the invention also in Finland under the application number FI 982728 and with an international patent application PCT/FI99/01036. These applications are also the priority applications of the above-mentioned U.S. application.

With the enclosed assignment the sole inventor, Harri Vatanen, has transferred his rights to said invention "Method and system for implementing digital signature" to Sonera Oy, which belongs to the same consolidated corporation as Sonera Smarttrust Oy, to which Sonera Oy has transferred the right. Sonera Oy owns Sonera Smarttrust in its entirety and in that regard they are one company. In the assignment it has been stated that the assignee gets a right to dispose the invention, and in addition, Vatanen has promised to sign all the necessary documents that are needed in order to confirm the assignment.

In addition, the inventor Vatanen has signed a power of attorney to the Finnish attorney of Sonera Smarttrust Oy Papula Rein Lahtela Oy (at present Papula Oy) for the international patent application PCT/FI99/01036 in order that one could also mention the USA in the international patent application. Enclosed is a copy of said power of attorney.

Enclosed please find an extract from the law about the employer's right to the inventions made by the employee with its translations into English. Section 4 of the law shows

that if the invention was made when fulfilling the duties of the employee in employment, then the rights to the invention belong to the employer. This is very unambiguous, and based on this, the right to the invention belongs clearly to the employer of Vatanen. We enclose a copy of the work contract which shows that Vatanen was in an employment relationship with Sonera Oy at the time the invention, i.e. the Finnish application FI 982728, was made.

Helsinki 22 February, 2002



Markku Simmelvuo,
European patent attorney
PAPULA OY

ASSIGNMENT

I/We hereby declare that I/we

Harri Vatanen

Have assigned to

Sonera Oy
P.O.Box 106, FIN-00051 Sonera
(Teollisuuskatu 15, 00510 Helsinki, Finland)

my/our right to invention, priority, patent
applications and patents, in all countries, on an
invention

SIIRTO

Vakuutan/Vakuutamme, että minä/me

Olen/olemme siirtäneet yritykselle

oikeuteni/oikeutemme keksintöön, etuoikeu-
teen, patenttihakemuksiin ja patentteihin
kaikissa maissa seuraavaan keksintöön:

titled by / nimitys: MENETELMÄ JA JÄRJESTELMÄ DIGITAALISEN ALLEKIRJOITUKSEN
TOTEUTTAMISEKSI
filed in Finland on / joka on pantu vireille Suomessa 16.12.1998

having the filing number / hakemusnumerolla 982728

and/or Sonera's case number / ja/tai Soneran asianumerolla

The assignment of the rights includes a
transfer of the patent rights in all countries, as
well as the right to use a convention priority of
the Finnish patent application in all countries.

The assignee alone hereinafter has the entire
disposal of the invention and possesses the
entire ownership to any domestic and foreign
patents granted thereafter. The assignor/s
undertake/s to sign all documents necessary
for taking out a patent and, furthermore, all
such documents which may be required to
assert rights transferred hereby.

If the assignor/s is/are prevented by any
obstacles from signing said documents in
person, this document of assignment shall be
valid as a Power of Attorney for the assignee
or for whom the rights have been transferred to
sign these documents on behalf of the
assignor/s or in the event of the death of the
latter, the estate thereof.

Oikeuksien siirto sisältää oikeuksien siirron
kaikissa maissa ja oikeuden käyttää etuoikeutta
suomalaisesta patenttihakemuksesta kaikissa
maissa.

Siirronsaajalla on tämän jälkeen keksintöön
määräämisoikeus ja hänellä on omistus-
oikeudet kaikkiin kotimaisiin ja ulkomaisiin
myönnettyihin patentteihin. Luovuttaja/luovut-
tajat lupaa/lupaavat allekirjoittaa kaikki tarpeel-
liset asiakirjat patentin luovuttamiseksi ja lisäksi
kaikki asiakirjat, jotka vaaditaan oikeuksien
siirron vahvistamiseksi.

Ios luovuttaja/luovuttajat on/ovat estynyt/esty-
neet allekirjoittamasta asiakirjoja henkilökohtai-
sesti, tämä siirtoasiakirja on pätevä asiamies-
valtakirjana siirronsaajalle tai sille, jolle
oikeudet on siirretty, näiden asiakirjojen
allekirjoittamiseksi luovuttajan/luovuttajien tai
jälkimmäisen/jälkimmäisten kuoleman tapauk-
sessa, sen/niiden kuolinpesän puolesta.

Place and date / Paikka ja aika Helsinki 20.12.1998

Signature of the assignors /
Luovuttajan/jien allekirjoitus



Clarification of signature/s
Allekirjoituksen selvennys

Harri Vatanen

Address of the assignor/s
Luovuttajan/jien osoite

Lepolantie 25 A 3

00660 Helsinki

Patentit, tavaramerkit ja mallit
 Patent, varumärken och mönster
 Patents, Trade Marks and Designs
 Patente, Warenzeichen und Muster

127145/
 1084

SUOMI
 FINLAND

By Express Mail
 No. EL727707030US

VALTAKIRJA

Taten

FULLMAKT

for

POWER OF ATTORNEY

to

VOLLMACHT

für

PAPULA REIN LAHTELA OY
 Patent and Trade Mark Attorneys
 P.O.Box 981, Fredinkinkatu 61 A, FIN-00101 Helsinki, Finland
 Telex: +358 9 3480 0630, 3480 0631

ta: määräämässä valtuutetaan
 edustamaan minua/meitä

eller förordnad att representera
 mig/oss

or any one whom they may appoint
 to represent me/us

oder von ihnen ernanntem, mich/
 uns

kansainvälisessä patenttihakemuksessa
 MENETELMÄ JA JÄRJESTELMÄ DIGITAALISEN
 ALLEKIRJOITUKSEN TOTEUTTAMISEKSI
 PCT/FI99/01036 - 15.12.1999

etuoikeus/priority: 16.12.1998 - FI - 982728

in international patent application
 METHOD AND SYSTEM FOR IMPLEMENTING
 A DIGITAL SIGNATURE

ja kaikessa, mikä asiaa, hakemus-
 ta, tästä jakamalla erotettuja ja lon-
 kaistuja hakemuksia ja hakemusten
 perusteella myönnettyjä suoja-
 oikeuksia koskeva, kantamaan ja vas-
 taamaan

och i allt vad beträffar ärendet, an-
 sökningen, därur avdelade och ut-
 brutna ansökningar och på grund
 av sagda ansökningar beviljade
 skyddsätter, för talan och svara.

and in everything concerning the
 matter, application, applications
 therefrom branched off or divided
 as well as protective rights granted
 on said applications, to pursue
 claim and to reply.

zu vertreten und in allem, was die
 Sache, Anmeldung, davon abge-
 teilte oder ausgeschiedene Anmel-
 dungen sowie auf Grund derselben
 erteilte Schutzrechte betrifft, zu
 klagen und zu antworten.

Paikka, päiväs ja
 näkijän allekirjoitus

Ort, datum och
 sökandens underskrift

Place, date and
 signature of Applicant

Ort, Datum und
 Unterschrift des Anmelders

Harri Varanen

Ei vahvistusta
 Ingen legalisering
 No legalization
 Keine Beglaubigung



Rekisteröidyt patenttiasiamiehet
 Registered Patent Attorneys
 European Patent Attorneys

PAPULA and NEVINPAT offices,
 specialists in industrial property
 rights in Finland and the former
 USSR countries.

By Express Mail
No. EL727707030US

1 §

In this law, a consolidated corporation is used to refer to a consolidated corporation in accordance with chapter 6 of section 1 of the Bookkeeping Act (1336/1997), as well as to a municipality and municipal federation and companies under its authority as referred to in subsection 2 of section 5 and section 6 of chapter 1 of the Bookkeeping Act.

4 §

If the invention is a result of activities carried out in order to fulfill the duties of an employee, or by utilizing the experience gained in a company or organization of the employer or in one belonging to the same consolidated corporation with it, the employer has the right, provided that the utilization of the invention is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it, to obtain the right to the invention either wholly or partially. If the invention was produced by the employee as a result of a duty more specifically defined in the employment, the employer has the aforementioned right, although the utilization of the invention is not included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it.

If it is a question about an invention the utilization of which is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it but which was produced in connection with an employment relationship other than prescribed by subsection 1, the employer is entitled to obtain the right of use of the invention.

If the employer wishes to obtain a right to an invention referred to in subsection 2 that is wider than the one prescribed in it, or a right to an invention that was produced without a connection to an employment relationship but the utilization of which, however, is included in the branch of business of the employer or in the one of a company belonging to the same consolidated corporation with it, the employer has the priority to obtain the right in question by agreeing on it with the employee.



UNITED STATES PATENT AND TRADEMARK OFFICE

By Express Mail
No. EL727707030USCommissioner for Patents,
United States Patent and Trademark
Office
Washington, D.C. 20590

| | | |
|-------------------------------|-----------------------|------------------|
| U.S. APPLICATION NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/868387 | VATANEN | H 2132-47PCON |
| INTERNATIONAL APPLICATION NO. | | |

LANCE J LIEBERMAN
COHEN PONTANI LIEBERMAN & PAVANE
SUITE 1210
551 FIFTH AVENUE
NEW YORK, NY 10176

PCT/FI99/01036

| | |
|------------------|---------------|
| I.A. FILING DATE | PRIORITY DATE |
| 15 DEC 99 | 16 DEC 98 |

DATE MAILED:

25 JUL 2000

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the application to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b), AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Shakeel Ahmed

Telephone: 703-305-3659



No. EL72770703

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark
Washington, D.C.

| | | |
|-------------------------------|-----------------------|------------------|
| U.S. APPLICATION NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/868387 | VATANEN | H 2132-47PCON |
| INTERNATIONAL APPLICATION NO. | | |
| PCT/FI99/01036 | | |
| I.A. FILING DATE | PRIORITY DATE | |
| 15 DEC 99 | 16 DEC 98 | |

LANCE J. LIEBERMAN
COHEN, PONTANI, LIEBERMAN & PAVANE
SUITE 1210
551 FIFTH AVENUE
NEW YORK, NY 10176

25 Sept 01

DATE MAILED: 25 JUL 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- | | |
|--|---|
| <input checked="" type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input checked="" type="checkbox"/> Copy of the international application. | <input type="checkbox"/> Translation of the international application into English. |
| <input checked="" type="checkbox"/> Oath or Declaration of inventors(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input type="checkbox"/> Other: |
| <input checked="" type="checkbox"/> Priority Document. | |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |

2. ☒ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.

7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☐ PCT/DO/EO/920

Shakeel Ahmed

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3659

P047640

COHEN, PONTANI, LIEBERMAN & PAVANE

COUNSELLORS AT LAW
PATENTS, TRADEMARKS & COPYRIGHTS
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By Express Mail
No. EL727707030US

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VINCENT M. FAZZARI
CATRIONA M. COLLINS
ALFRED W. FROEBRICH
ALFRED H. HEMINGWAY, JR.
KENT H. CHENG, PH.D.
ROGER S. THOMPSON
JEREMY A. KAUFMAN
GEORGE J. BRANDT, JR.
TEODOR J. HOLMBERG
F. BRICE FALLER

August 3, 2001

VIA FAX: 011 358 9 3480 0630

Markku Simmelvu, Esq.
Papula Oy
Box 981
SF-00101 Helsinki
Finland

REMINDER

19 October 2001

Re: U.S. National Phase PCT Application Serial No. 09/868,387
For: Method and System for Implementing a Digital Signature
Your Ref.: 14705S
Our File No.: 2132-47PCON

Dear Markku:

Pursuant to our letter of 27 June 2001, the above-identified patent application was filed in unexecuted condition. We have now received a form from the United States Patent and Trademark Office entitled NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. § 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) which is enclosed for your files. We have until 25 September 2001, in order to file the executed Declaration and Power of Attorney.

If you have any questions, please do not hesitate to contact us.

Very truly yours,

COHEN, PONTANI, LIEBERMAN & PAVANE



Lance J. Lieberman

LJL/LAK
Enlosure

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) or PCT international application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in that/those prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application:

PRIOR U.S. APPLICATIONS OR PCT INTERNATIONAL APPLICATIONS DESIGNATING THE U.S. FOR BENEFIT UNDER 35 U.S.C. 120:

| U.S. APPLICATIONS | | | STATUS (check one) | | |
|---------------------------------------|------------------|---------------------------------------|--------------------|---------|-----------|
| U.S. APPLICATION NUMBER | U.S. FILING DATE | | PATENTED | PENDING | ABANDONED |
| | | | | | |
| | | | | | |
| | | | | | |
| PCT APPLICATIONS DESIGNATING THE U.S. | | | | | |
| PCT APPLICATION NO. | PCT FILING DATE | U.S. SERIAL NUMBERS ASSIGNED (if any) | | | |
| PCT/FI99/01036 | 15 December 1999 | | | X | |
| | | | | | |

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith (*List name and registration number*)

MYRON COHEN, Reg. No. 17,358; THOMAS C. PONTANI, Reg. No. 29,763; LANCE J. LIEBERMAN, Reg. No. 28,437; MARTIN B. PAVANE, Reg. No. 28,337; MICHAEL C. STUART, Reg. No. 35,698; KLAUS P. STOFFEL, Reg. No. 31,668; EDWARD M. WEISZ, Reg. No. 37,257; JULIA S. KIM, Reg. No. 36,567; VINCENT M. FAZZARI, Reg. No. 26,879; ALFRED W. FROEBRICH, Reg. No. 38,887; KENT H. CHENG, Reg. No. 33,849; ROGER S. THOMPSON, Reg. No. 29,594; GEORGE J. BRANDT, JR., Reg. No. 22,021; F. BRICE FALLER, Reg. No. 29,532 and YUNLING REN, Reg. No. 47,019,

Send correspondence to:

Lance J. Lieberman
Reg. No. 28,437
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, New York 10176

Direct Telephone calls to:

(name and telephone number)
Lance J. Lieberman
(212) 687-2770

| | | | | |
|-----|------------------------|---|---|--|
| 201 | FULL NAME OF INVENTOR | FAMILY NAME VATANEN | FIRST GIVEN NAME Harri | SECOND GIVEN NAME |
| | RESIDENCE, CITIZENSHIP | CITY Englefield Green, Surrey | STATE OR FOREIGN COUNTRY Great Britain | COUNTRY OF CITIZENSHIP Finland |
| | POST OFFICE ADDRESS | POST OFFICE ADDRESS 2 Rushmore Place | CITY Englefield Green, Surrey | STATE & ZIP CODE/COUNTRY Great Britain TW 20 0NN |
| 202 | FULL NAME OF INVENTOR | FAMILY NAME | FIRST GIVEN NAME | SECOND GIVEN NAME |
| | RESIDENCE, CITIZENSHIP | CITY | STATE OR FOREIGN COUNTRY | COUNTRY OF CITIZENSHIP |
| | POST OFFICE ADDRESS | POST OFFICE ADDRESS | CITY | STATE & ZIP CODE/COUNTRY |

| | | | | |
|--|------------------------|---------------------------|--------------------------|--|
| Combined Declaration for Patent Application and Power of Attorney (Continuation) (Includes Reference to PCT International Applications) | | | | Attorney's Docket No. 2132-47PCON |
| 2 0 3 | FULL NAME OF INVENTOR | FAMILY NAME | FIRST GIVEN NAME | SECOND GIVEN NAME |
| | RESIDENCE, CITIZENSHIP | CITY | STATE OR FOREIGN COUNTRY | COUNTRY OF CITIZENSHIP |
| | POST OFFICE ADDRESS | POST OFFICE ADDRESS | CITY | STATE & ZIP CODE/COUNTRY |
| <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.</p> | | | | |
| SIGNATURE OF INVENTOR 201 | | SIGNATURE OF INVENTOR 202 | | SIGNATURE OF INVENTOR 203 |
| DATE | | DATE | | DATE |

4

By Express Mail
No. EL727707030US

IN THE US PATENT AND TRADE-MARK OFFICE

IN THE MATTER OF US 09/868 387 for the FI-982728, 16.12.1998
METHOD AND SYSTEM FOR IMPLEMENTING A DIGITAL SIGNA-
TURE

AFFIDAVIT FOR THE ABOVE NOTED MATTER IN THE US PATENT AND TRADE MARK OFFICE


I, Paivi Soderman, of Sonera Smarttrust Oy, MAKE OATH AND SAY AS
FOLLOWS:

1. I am employed by Sonera Smarttrust Oy of Helsinki, Finland
2. I am currently overseeing the matter of the registration of US pat-
ent application US 09/868387 for us.
3. In 1998, we filed a patent application FI 982728. The application
was filed on December 6, 1998.
4. In 1999 we filed an international application under the Patent Co-
Operation Treaty (hereinafter "PCT") claiming the Finnish filing
date as the priority date.
5. We prepared the Finnish patent application FI 982728, and, the
PCT-application, PCT/FI99/01036, under the direction of Mr
Harri Vatanen, employee of Sonera Oy at that time. Mr. Vatanen
was also the sole inventor of the subject patent. At the time, Mr.
Vatanen signed all documents on behalf of Sonera Oy.
6. According to Finnish law, and more specifically, to the statute of
the Laws of Employees Inventions, all inventions created during
the time of an individual's employment with a company, are prop-
erty of the employer. To ensure patenting of the subject invention
Mr. Vatanen should execute all documents which are needed for
the patent process because he was an employee of Sonera Oy and
participated in creation of the invention. Attached hereto is an
other assignment related to the same invention, which is signed by
Mr. Vatanen. It serves as evidence to demonstrate the co-
operation of Mr. Vatanen prior to his decision not to execute
documents needed for the subject patent.
7. According to the law and decree of employee inventions, Sonera
Oy has the rights to the invention in question and Mr. Vatanen is
obliged to sign all the documents needed in the patenting process
with respect of the invention.

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8. Again referring to said assignment signed by Mr. Varanen, it confirms that the rights to the subject invention, under the Finnish law belong to Sonera Oy. By executing the patent document, he relinquishes his interests and rights to the invention.
9. Within 30 months from the priority date, June 18, 2001, the international application entered the national stage.
10. On or about July, 2001, we prepared the declaration for the US national phase application. After that, we delivered the declaration together with the specification to Harri Varanen but did not receive any signed declaration. He has, however, over and over again promised to sign the documents. Nevertheless, Harri Varanen has to this day not sent us any signed documents in spite of the fact that we have forwarded the declaration documents to him more than once.
11. As I have not received any signed declaration, despite of many promises from Mr. Varanen, I regard this as a refusal of signing a declaration.

HELSINKI 21.2.2002



PAIVI SÖDERMAN

ASSIGNMENT

SIIRTO

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No. EL727707030US

I/We hereby declare that I/we

Vakuutan/Vakuutamme, että minä/me

Harri Vatanen

Have assigned to

Olen/olemme siirtäneet yritykselle

Sonera Oy

P.O.Box 106, FIN-00051 Sonera

(Teollisuuskatu 15, 00510 Helsinki, Finland)

my/our right to invention, priority, patent applications and patents, in all countries, on an invention

oikeuteni/oikeutemme keksintöön, etuoikeuteen, patentihakemuksiin ja patenteihin kaikissa maissa seuraavaan keksintöön:

titled by / nimitys: MENETELMÄ JA JÄRJESTELMÄ DIGITAALISEN ALLEKIRJOITUKSEN TOTEUTTAMISEKSI

filed in Finland on / joka on pantu vireille Suomessa 16.12.1998

having the filing number / hakemusnumerolla 982728

and/or Sonera's case number / ja/tai Soneran asianumerolla

The assignment of the rights includes a transfer of the patent rights in all countries, as well as the right to use a convention priority of the Finnish patent application in all countries.

Oikeuksien siirto sisältää oikeuksien siirron kaikissa maissa ja oikeuden käyttää etuoikeutta suomalaisesta patentihakemuksesta kaikissa maissa.


The assignee alone hereinafter has the entire disposal of the invention and possesses the entire ownership to any domestic and foreign patents granted thereafter. The assignor/s undertake/s to sign all documents necessary for taking out a patent and, furthermore, all such documents which may be required to assert rights transferred hereby.

Siirronsaajalla on tämän jälkeen keksintöön määräämisoikeus ja hänellä on omistus-oikeudet kaikkiin kotimaisiin ja ulkomaisiin myönnettyihin patenteihin. Luovuttaja/luovuttajat lupaa/lupaavat allekirjoittaa kaikki tarpeelliset asiakirjat patentin luovuttamiseksi ja lisäksi kaikki asiakirjat, jotka vaaditaan oikeuksien siirron vahvistamiseksi.

If the assignor/s is/are prevented by any obstacles from signing said documents in person, this document of assignment shall be valid as a Power of Attorney for the assignee or for whom the rights have been transferred to sign these documents on behalf of the assignor/s or in the event of the death of the latter, the estate thereof.

Jos luovuttaja/luovuttajat on/ovat estynyt/estyneet allekirjoittamasta asiakirjoja henkilökohtaisesti, tämä siirtoasiakirja on pätevä asiamiesvaltakirjana siirronsaajalle tai sille, jolle oikeudet on siirretty, näiden asiakirjojen allekirjoittamiseksi luovuttajan/luovuttajien tai jälkimmäisen/jälkimmäisten kuoleman tapauksessa, sen/niiden kuolinpesän puolesta.

Place and date / Paikka ja aika Helsinki 20.12.1998

Signature of the assignors /
Luovuttajan/jien allekirjoitus

Clarification of signature/s
Allekirjoituksen selvennys

Harri Vatanen

Address of the assignor/s
Luovuttajan/jien osoite

Lepolantie 25 A 3

00660 Helsinki

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No. EL727707030US

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

METHOD AND SYSTEM FOR IMPLEMENTING A DIGITAL SIGNATURE

the specification of which has been filed under Serial No. 09/868,387

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56(a).

I also acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37 CFR 1.63(d), which occurred between the filing date of the prior application and the filing date of the continuation-in-part application, if this is a continuation-in-part application

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

| | | |
|----------------------------|-------------|--------------|
| Prior Foreign Application: | Country: | Finland |
| | Appln. No.: | 982728 |
| | Filed: | 16 Dec. 1998 |

| | | |
|----------------------------|-------------|----------------|
| Prior Foreign Application: | Country: | PCT |
| | Appln. No.: | PCT/FI99/01036 |
| | Filed: | 15 Dec. 1999 |

I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Address all telephone calls to Lance J. Lieberman, Esq. at telephone No. (212) 687-2770.

Address all correspondence to:

Lance J. Lieberman, Esq.
Cohen, Portant, Lieberman & Pavane
551 Fifth Avenue, Suite 1210
New York, New York 10176

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made

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with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Sole or First Inventor: Harri VATANEN

Inventor's signature: _____

Dated: _____
Month/Day/Year

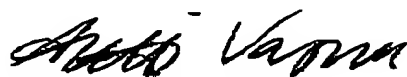
Residence: **United Kingdom**

Citizenship: **Finland**

Post Office Address: **Savannah Lindale Close, Virginia Water GU 4NT Surrey
United Kingdom**

On behalf of Harri Vatanen

Dated: _____


Sonera Smarttrust Oy
name: Antti Vasara
title: CEO